

REMARKS

Applicants respectfully request reconsideration of the instant application in light of the forgoing amendments and the following remarks. Claims 1-34 are currently pending in the application. By this Amendment, Applicants have amended claims 4, 16, 26 and 28 to correct minor typographical errors. Applicants submit that no new matter has been added by way of this Amendment.

Rejection Under 35 USC § 103(a)

Independent claims 1, 16 and 21, as well as dependent claim 2, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Examiner's assertion of Cwener US 5,893,079 (hereinafter, "Cwener") in view of Rhonda Bissig, "Merrill, ex-broker hit with multi-million dollar lawsuit in N.H.," Wall Street Letter, New York: Feb. 7, 2000. Vol. 32, Iss. 6; pp. 1-2 (hereinafter, "Bissig"). The Examiner further rejects dependent claims 3-15, 17-20 and 22-34 under 35 U.S.C. § 103(a) as being unpatentable over the Examiner's assertion of Cwener in view of both Bissig and so-called "Applicant's Admitted Prior Art" (hereinafter, "APA"). Applicants respectfully traverse the Examiner's characterization of the APA and reserve the right to argue against that characterization at a later time. Applicants respectfully traverse the Examiner's rejection and submit that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

Independent Claim 1 Is Patentable

Independent claim 1 recites, *inter alia*:

- ...
- (b) retrieving restrictions associated with the particular instrument from a collection of restrictions;
- (c) accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the

party, the profile reflecting at least the relationship between the party and the entity;

(d) evaluating at least a portion of the rules in the compliance rule set using the retrieved restrictions to determine if the request complies with the restrictions;...

Applicants submit that the cited references, taken either alone or in combination, in no way teach, disclose, or suggest at least retrieving restrictions associated with the particular instrument from a collection of restrictions, accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party, the profile reflecting at least the relationship between the party and the entity, and evaluating at least a portion of the rules in the compliance rule set using the retrieved restrictions to determine if the request complies with the restrictions, as recited in independent claim 1.

In the October 9, 2007 Office Action, the Examiner asserts, "Cwener discloses ... (b) retrieving restrictions associated with the particular instrument from a collection of restrictions [Figure 5; col. 1 lines 11-20; col. 5 lines 22-25; col. 11 line 34 to col. 12 line 48 - violation of rules] ..." (p. 2, ¶ 3). Applicants respectfully traverse the Examiner's assertion.

Instead of discussing the claimed elements as alleged by the Examiner, Figure 5 shows a general illustration of logic flow for a compliance embodiment of the Cwener system, whereby transactions are compared against legal and business preference rules. The rules in this figure, described in the co-cited section col. 11 line 34 to col. 12 line 48, are not analogous to the "restrictions" recited in the claim element. For example, independent claim 1 recites, *inter alia*, "restrictions associated with the particular instrument." Nothing in either Fig. 5 of Cwener or in Cwener's discussion of Fig. 5 indicates that any of the rules are associated with any particular instrument.

Furthermore, independent claim 1 explicitly recites both "restrictions" and "compliance rules", with the former used to evaluate the latter in element (d). Nothing in the

cited portions of Cwener is analogous to these elements as recited in independent claim 1. Instead of supporting the Examiner's assertions, Col. 1 lines 11-20 of Cwener merely describes general uses for Cwener's system, and col. 5 lines 22-25 discusses functions of the central database. Neither of these passages seems plainly relevant to element (b) of independent claim 1, as alleged by the Examiner. Should the Examiner maintain this rejection, Applicants respectfully request further clarification of the relevance of these cited portions of Cwener to independent claim 1.

In the October 9, 2007 Office Action, the Examiner further asserts, "(c) accessing a compliance rule set identifying at least one compliance rule selected in accordance with a profile associated with the party [col. 10 lines 23-35 - "rules have been established with respect to a specific user"]." (p. 2, ¶ 3). Applicants respectfully traverse the Examiner's assertion. The cited portion of Cwener merely describes the accessing of Cwener's system by external user workstations, and the alleged "rules" described in the cited section regulate the access of these workstations to data stored in the system's central database. At no time does the cited portion teach, suggest, or disclose a "compliance rule set", much less one that identifies, "at least one compliance rule selected in accordance with a profile associated with the party," as recited in independent claim 1. In fact, there is no discussion of a profile anywhere in Cwener.

In the October 9, 2007 Office Action, the Examiner further asserts, "(d) evaluating at least a portion of the rules in the compliance rule set using the retrieved restrictions to determine if the request complies with the restrictions [col. 2 lines 42-51; col. 11 line 34 to col. 12 line 48]." (p. 2, ¶ 3). Applicants respectfully traverse the Examiner's assertion. As noted before, Cwener's system addresses compliance issues by a direct comparison of trades and rules. For example, in col. 2, lines 42-51, Cwener describes a system to, "compare a proposed trade

with a group of rules ..." However, element (d) of claim 1 in the instant application recites, "evaluating at least a portion of the rules in the compliance rule set using the retrieved restrictions ..." At no time is such an approach taught, suggested, or disclosed in any of the cited portions of the reference. Even if, *arguendo*, the Examiner's assertions regarding claim elements (b) and (c) were correct, Cwener does not teach, suggest, or disclose the use of the components from those elements within the context recited by element (d) of independent claim 1.

Accordingly, claim 1 is not rendered obvious under § 103(a), for at least the reasons discussed above with regard to the deficiencies of the cited references. Thus, Applicants respectfully request that the Examiner withdraw the rejection and allow claim 1 as well as claims directly or indirectly depending thereon. Should the Examiner maintain his position regarding claim 1 and elements (b), (c) and (d), Applicants request that the Examiner provide guidance to specific passages within the cited references that discuss restrictions, compliance rules, and evaluating the latter using the former, as recited and used within the context of independent claim 1.

Independent Claims 16 and 21 Are Patentable

In the October 9, 2007 Office Action, the Examiner asserts, "... claims 16 and 21 are rejected with the same rational [sic] & analysis as claim 1." (p. 4, ¶ 1). Applicants submit that claims 16 and 21 include elements similar to element (e) in claim 1, and are therefore patentable for at least the same reasons as those given above for claim 1.

Furthermore, claims 16 and 21 include additional claim elements not present in claim 1 that the Examiner has not specifically addressed in his rejection. MPEP § 706.02(j) states, "To establish a *prima facie* case of obviousness ... the prior art reference (or references

when combined) must teach or suggest all the claim limitations." (emphasis added). Similarly, MPEP § 2143.03 states, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (emphasis added). By way of example only, Applicants direct the Examiner's attention to element (a) of claim 16, which recites, *inter alia*, "compliance rules having an associated priority," and to element (e) of claim 16, which recites, *inter alia*, "generating a compliance rule set ... by combining a baseline rule set and at least one additional rule set selected in accordance with the party profile." In a further example, claim 21 recites elements such as, "a list server ... configured to receive a query indicating a particular instrument and return data indicating restrictions associated with the particular instrument," "a rules database," "a profile database," and, "a rules engine". As many of the limitations present in claims 16 and 21 are plainly absent in claim 1, Applicants submit that a *prima facie* case of obviousness has not been established for either of these claims by the Examiner's arguments rejecting claim 1.

Accordingly, claims 16 and 21 are not rendered obvious under § 103(a), as recited elements have not been addressed by the cited references. Applicants respectfully request that the Examiner withdraw the rejection and allow claims 16 and 21 and claims depending thereon. Should the Examiner maintain his position, Applicants request that the Examiner provide specific passages addressing the specific and distinct limitations present in claims 16 and 21.

CONCLUSION

Consequently, the reference(s) cited and/or any official notice taken by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed

invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant does not concede that any such elements are found in the prior art and/or within any official notice taken in the office action, and as such, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art, including any official notice taken in the office action, and explicitly reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-019.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-019

Respectfully submitted,
CHADBOURNE & PARKE, L.L.P.

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By: /Walter G. Hanchuk/
Walter G. Hanchuk Reg. No. 35,179

Chadbourne & Parke LLP
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile